Overview of the checking process for Pre-Grant Publications

What will be checked

The contract payment and evaluations will be based on the sample size set forth in Section B.13.1 of the RFP. The USPTO may review additional applications as it deems necessary to provide constructive feedback to the contractor.

Other quality monitoring by the USPTO will include determining if the contractor selected the correct representative figure and if the contractor performed the offensive material review correctly. In addition, classifications and information provided by the contractor related to the correction of classifications for issuing US patents, Pre-Grant classification changes and research/justification of classifications will be checked.

Who will do the checking

The USPTO currently envisions utilizing reviewers, e.g. Supervisory Patent Examiners (SPEs), examiners, or other USPTO designated representatives, to handle most of the quality monitoring work. Initially, any potential errors identified will be forwarded to OPC (Office of Patent Classification) to determine if the potential errors found were appropriate for charging as errors against the contractor. OPC will determine if the error is actually an error or would constitute a reasonable difference of opinion sometimes found in the assignment of classifications. As part of their evaluation, OPC would ensure that errors are not assessed based on informal practices or guidance not provided to the contractor. OPC will provide technical and administrative support, e.g., documenting errors, compiling statistics.

In the vast majority of situations, no further consideration of the classifications will be necessary. Classification errors determined by OPC will be returned to the contractor along with justification. The justification given to the contractor will help improve the classifications of future applications and patent documents. Upon notification of incorrect classifications, the contractor shall within 3 business days after notification either (1) correct the classification or (2) appeal the error designation and provide rationale to the Contracting Officer's Representative (COR). If appealed, OPC will reconsider the error in light of any information provided by the contractor and notify the contractor of its final decision through the COR.

Determination of what constitutes an error

Unexamined patent applications have obviously not gone through the examination process and thus may not have had all issues resolved to the level present in granted patents. As a result, choosing precisely the content that should be classified into a proper USPC class or IPC Subclass can be somewhat subjective. This is more often a problem in determining the proper USPC class, rather than a particular subclass.

Contractors are required to use the claims read in light of the disclosure (i.e., claimed disclosure) along with any special USPTO guidance to determine USPC and IPC classifications of unexamined applications (also see paragraph 129 of the Guide to the IPC (Eighth Edition). USPTO's reviewers, on the other hand, may use their more

detailed knowledge of the prior art, subject matter, etc. to determine the classifications of these unexamined applications. Granted patents have been examined and can, of course, be classified by their claimed disclosure by both contractors and USPTO's reviewers. See the Handbook of Classification for details on how to classify in the US Patent Classification system (USPC) (http://www.uspto.gov/web/offices/opc/documents/handbook.pdf) and the Guide to the IPC on for details on how to classify in the IPC system (http://www.wipo.int/classifications/ipc/en/).

A fair assessment of classification errors requires someone (OPC) to review the classifications assigned by both the contractor and the USPTO's reviewers after considering the claims and disclosure in the patent application. Discrepancies resulting from a reasonable interpretation of the claims and the disclosure will not be counted as errors. Furthermore, discrepancies caused by a USPTO's reviewer basing a determination of a proper classification on his/her detailed knowledge of the subject matter historically classified in a particular classification will not be counted as an error, since the contractor bases the determination solely on the claimed disclosure of the application, classification titles, definitions notes, and any art specific guidance provided by the government.

Experience in evaluating the classifications assigned to applications and patent documents in the USPTO shows that there are three primary causes of errors in classification:

1. The classifications of all claims in an application or patent have not been considered. (See Handbook of Classification, Section II and Example 1 below.)
2. The furthest indented USPC subclass or IPC subgroup has not been chosen based on the claimed disclosure of the application or patent. (See Handbook of Classification section IV, and subsection B, 4, in particular and Example 2 below.)
3. A coordinate subclass higher in the schedule provides for the subject matter (Also see Handbook of Classification section IV, and subsection B, 4, in particular and Example 1.)

Obvious types of errors also occur, such as classifying a paper fastener in a wood fastener class, but these types of errors are much less common.

Other errors are considered less significant to the subsequent processing and use of the documents by the USPTO. For example, an error in the primary classification would not be charged unless the incorrect designation of the primary classification resulted in the application being routed to the incorrect art unit. This would happen when multiple mandatory classifications for a particular application are examined in the same art unit, and even though the wrong mandatory classification was selected as primary, the application was still routed to the correct art unit. Another example is if the contractor incorrectly designates a species as the primary classification and designates the genus as

a mandatory cross-reference instead of vice versa, this is not considered an error as long as all correct classifications are provided.

Use of the USPC to IPC statistical concordance

The USPTO has generated a statistical USPC to IPC concordance that will provide information regarding the relationships between USPC subclasses and IPC subgroups. The relative strength of these relationships will be provided by the PGClass interface and, if desired, in a separate file. The relative strength of concordance between the USPC and IPC classifications will be indicated by a scale of 0-99 with 0 being the strongest (a one-to-one relationship known as a "lock-on") and 99 being the weakest. Applications having classifications designated as "lock-ons" will merely need to have the IPC data entered by the contractor.

Most USPC subclasses, however, do not currently have a one-to-one relationship with IPC subgroups and thus will need to have IPC classifications determined by the contractor. While the USPC to IPC concordance can be a very useful aid in classifying applications having such USPC classifications, the contractor will need to determine if the IPC classifications are proper for a particular application. These applications will be checked according to the procedures outlined above.

A few examples of errors are provided below:

Example 1

See the sample schedule below.

10 WITH SOUNDING DEVICE
11 . Whistle
12 TYPE A DEVICE
13 . Details
14 TYPE B DEVICE
15 . Details
16 TYPE C DEVICE
17 . Details

Assume an application has a large number of claims, most of which would be properly classified near the bottom of a USPC schedule according to the details of the device. Also assume that a dependent claim stated that it was a Type C device with a whistle as a sounding device. In the sample schedule shown, the primary classification would be in subclass 11, the "Whistle" subclass, because it is the deepest appropriate indent highest appearing in the schedule. If subclasses 11 and 17 are examined in different art units, the contractor would be charged an error if a primary classification was assigned in subclass 17 even if subclass 11 was indicated a mandatory classification as well. This is true even if the other claims gave much more detail about the Type C device and the whistle was believed to be an ancillary feature. If, however, subclass 11 and subclass 17 are

examined in the same art unit, both were indicated as mandatory classifications, and the only mistake was designating 17 primary rather than 11, no error would be charged.

Example 2

Using the same sample schedule, if the claim only claimed a sounding device, but was disclosed as a whistle in the specification, then the classification would be in the "Whistle" subclass. The contractor would be charged an error in determining mandatory classifications if he/she assigned the "WITH SOUNDING DEVICE" classification rather than recognizing the "Whistle" indent applies. If both subclasses are examined in the same art unit, an error in designation of the primary would not be additionally charged.

Example 3

Using the same sample, if no specific type of sounding device was disclosed even though it was claimed, the contractor would be correct if the "WITH SOUNDING DEVICE" classification was assigned. If the USPTO reviewer reviewing the contractor's work indicated that the "Whistle" classification should be used because she knew the only kind of sounding devices used in such situations were whistles, no error would be charged to the contractor. The contractor only needs to consider the claims in light of the disclosure.

Example 4

Assume an application claims a cutter, but the disclosure is so vague that reasonable people believe different types of cutters are being claimed and disclosed or that no specific type of cutter is being claimed. The application could be assigned to a number of cutter classes in the USPC. If the reviewer, based on detailed knowledge of the subject matter or based on a different assumption, indicates the contractor should have selected another class, the discrepancy would not be counted as an error.